

**REMARKS**

Claims 1-22 are currently pending in the application. By this amendment, claims 11, 12, 16-20 and 23-25 are amended as to minor formal matters. The above amendments do not add new matter to the application and are fully supported by the specification. Reconsideration of the rejected claims in view of the above amendments and the following remarks is respectfully requested.

***Present Amendment is proper for entry***

Applicants respectfully submit that the instant amendment is proper for entry after final rejection. Applicants note that no question of new matter is presented nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required. Moreover, Applicants submit that the instant amendment places the application in condition for allowance, or at least in better form for appeal. Accordingly, Applicants request the Examiner to enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

***The Finality of the Instant Office Action is Improper***

In the Section 103(a) rejection of claims 3 and 20-22, the Examiner has identified LANZETTA and FLOTOTTO as forming the basis of the rejection. However, the rejection discusses US patent No. 3,297,322 to ERNST in the body of the rejection. While the Examiner has referenced a corresponding rejection in the previous non-final Office Action, that rejection was similarly improper. Thus, Applicants submits that the Examiner has failed to issue a proper rejection under Section 103(a) consistent with current USPTO policy and practice. The rejection should therefore be reversed, or at least clarified in a new non-final Office Action so that Applicants can properly and fully address the merits of the Examiner's assertions.

**35 U.S.C. §112, 1<sup>st</sup> Paragraph, Rejections****Best Mode**

Claims 1-25 were rejected under 35 U.S.C. §112, First Paragraph, as failing to disclose the best mode. This rejection is respectfully traversed.

The Examiner points to the language in the specification indicating that “the lower rail covers 410 are comprised of a specially formulated urethane material manufactured by a proprietary method” is support of the argument that the specification does not disclose the best material suitable for the invention.

Applicants respectfully disagree and submit that the instant rejection is improper and contrary to current USPTO rules.

MPEP 2165 sets forth the test for best mode as follows:

The specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The best mode requirement creates a statutory bargained-for-exchange by which a patentee obtains the right to exclude others from practicing the claimed invention for a certain time period, and the public receives knowledge of the preferred embodiments for practicing the claimed invention." *Eli Lilly & Co. v. Barr Laboratories Inc.*, 251 F.3d 955, 963, 58 USPQ2d 1865, 1874 (Fed. Cir. 2001).

The best mode requirement is a safeguard against the desire on the part of some people to obtain patent protection without making a full disclosure as required by the statute. The requirement does not permit inventors to disclose only what they know to be their second-best embodiment, while retaining the best for themselves. *In re Nelson*, 280 F.2d 172, 126 USPQ 242 (CCPA 1960).

Determining compliance with the best mode requirement requires a two-prong inquiry. First, it must be determined whether, at the time the application was filed, the inventor possessed a best mode for practicing the invention. This is a subjective inquiry which focuses on the inventor's state of mind at the time of filing. Second, if the inventor did possess a best mode, it must be determined whether the written description disclosed the best mode such that a person skilled in the art could practice it. This is an objective inquiry, focusing on the scope of the claimed invention and the level of skill in the art. *Eli Lilly & Co. v. Barr*

*Laboratories Inc.*, 251 F.3d 955, 963, 58 USPQ2d 1865, 1874 (Fed. Cir. 2001).

The failure to disclose a better method will not invalidate a patent if the inventor, at the time of filing the application, did not know of the better method OR did not appreciate that it was the best method. All applicants are required to disclose for the claimed subject matter the best mode contemplated by the inventor even though applicant may not have been the discoverer of that mode. *Benger Labs. Ltd. v. R.K. Laros Co.*, 209 F. Supp. 639, 135 USPQ 11 (E.D. Pa. 1962).

**ACTIVE CONCEALMENT OR GROSSLY INEQUITABLE CONDUCT IS NOT REQUIRED TO ESTABLISH FAILURE TO DISCLOSE THE BEST MODE**

Failure to disclose the best mode need not rise to the level of active concealment or grossly inequitable conduct in order to support a rejection or invalidate a patent. Where an inventor knows of a specific material that will make possible the successful reproduction of the effects claimed by the patent, but does not disclose it, speaking instead in terms of broad categories, the best mode requirement has not been satisfied. *Union Carbide Corp. v. Borg-Warner*, 550 F.2d 555, 193 USPQ 1 (6th Cir. 1977).

If the failure to set forth the best mode in a patent disclosure is the result of inequitable conduct (e.g., where the patent specification omitted crucial ingredients and disclosed a fictitious and inoperable slurry as Example 1), not only is that patent in danger of being held unenforceable, but other patents dealing with the same technology that are sought to be enforced in the same cause of action are subject to being held unenforceable. *Consolidated Aluminum Corp. v. Foseco Inc.*, 910 F.2d 804, 15 USPQ2d 1481 (Fed. Cir. 1990).

As this language clearly explains, best mode requires applicants “to disclose for the claimed subject matter the best mode contemplated by the inventor even though applicant may not have been the discoverer of that mode” (emphasis added).

Applicants note that the claims clearly do not recite a lower track rail cover. Instead, they broadly recite track rail covers.

As the Examiner has not asserted that the recited claim feature “track rail covers” fails the best mode requirement, the Examiner’s basis of rejection is without merit.

The Examiner is respectfully requested to consider that Applicants have broadly

claimed track rail covers and discloses various materials which may be used for such features. The disclosure is sufficient for what it claims. Thus, it is respectfully submitted that the disclosure is objectively sufficient in terms which correspond in scope to the claims. Furthermore, the specification describes the invention in such detail as to enable a person skilled in the most relevant art to make and use it.

Thus, the above noted best mode rejection is respectfully traversed for the reasons stated above as well as those already made of record. Furthermore, the Examiner is respectfully requested to consider that he has not met the initial burden of establishing best mode, and that such a rejection is manifestly improper.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-22 under 35 U.S.C. § 112, first paragraph.

#### Enablement

Claims 1-25 were rejected under 35 U.S.C. §112, First Paragraph, as failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Examiner points to the language in the specification indicating that “the lower rail covers 410 are comprised of a specially formulated urethane material manufactured by a proprietary method” is support of the argument that the specification does not provide enabling disclosure for the invention.

Applicants respectfully disagree and submit that the instant rejection is improper and contrary to current USPTO rules.

MPEP 2164.01 sets forth the test for enablement as follows:

Any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). Accordingly, even though the statute does

not use the term "undue experimentation," it has been interpreted to require that the claimed invention be enabled so that any person skilled in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404 (Fed. Cir. 1988). See also *United States v. Teletronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) ("The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation."). A patent need not teach, and preferably omits, what is well known in the art. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), *cert. denied*, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984). Determining enablement is a question of law based on underlying factual findings. *In re Vaack*, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991); *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 1576, 224 USPQ 409, 413 (Fed. Cir. 1984).

### **UNDUE EXPERIMENTATION**

The fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom.*, *Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

As this language clearly explains, a determination "of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. " As explained above, the claims do not recite a lower track rail cover. Instead, they broadly recite track rail covers. As the Examiner has not asserted that the recited claim feature "track rail covers" fails the enablement requirement, the Examiner's basis of rejection is without merit.

Applicants remind the Examiner that Applicants are entitled to claim the invention in broad terms and the Examiner is not free to reject claims merely on the basis that the

Examiner believes the claims to be too broad.

Finally, the Examiner should note that it is settled case law that the PTO has the initial burden of giving reasons, supported by the record as a whole, why the specification is non-enabling and to show that the disclosure entails undue experimentation. *In re Angstadt*, 190 USPQ 214, 219 (C.C.P.A. 1976).

Applicants submit that the Examiner has not met this initial burden. In the outstanding office action, the Examiner stated that Applicants have failed to set forth enabling disclosure for the lower track cover. Such statements are not an explanation of why and how the specification is non-enabling. Moreover, there has been no showing that the disclosure entails undue experimentation.

It has long been established that the specification need describe the invention only in such detail as to enable a person skilled in the most relevant art to make and use it. *In re Naquin*, 158 USPQ 317, 319 (C.C.P.A. 1968). It is submitted that those having ordinary skill in the art of ball return mechanisms are sufficiently informed by the disclosure to make and use the invention as claimed. Moreover, the invention is not limited to any particular type of track rail cover, much less, one which requires both upper and lower track rail covers. Rather, any conventionally known track rail covers can be utilized. Such conventional features, as taught by US patent 6,368,228 to LANZATTA, need not be described in great detail for enablement.

Moreover, Section 112, First paragraph requires that the scope of the claims bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art. *In re Fisher*, 166 USPQ 18, 24 (C.C.P.A. 1970). Applicants submit that the scope of the claims is broadly defined to include many possible track rail covers including those disclosed in the instant specification. Thus, the invention is not limited to any specific track rail covers, much less, one requiring lower track rail covers, but rather is directed broadly to many types of such track rail covers, as would be understood by one having ordinary skill in the art.

It has also consistently been held that Section 112, First paragraph requires nothing more than objective enablement. *Staehelin v. Secher*, 24 USPQ 2d 1513,

1516 (B.P.A.I. 1992). The Examiner's apparent preference for more detail of this feature is a subjective requirement which would pose an unnecessary burden on Applicants. Again, as stated above, in satisfying the enablement requirement, an application needs to supply disclosure only in terms which correspond in scope to the claims. *Staehelin*, 24 USPQ 2d 1513, 1516 (B.P.A.I. 1992). The claims recite broadly "track rail covers", and this aspect is fully described in the specification sufficiently to enable one having ordinary skill in the art to make and use the invention. Thus, since the scope of the claims is broad, the scope of the specification may also be correspondingly so. The Examiner is respectfully requested to consider that Applicants have broadly claimed track rail covers and not upper and lower track rail covers. The disclosure is clearly sufficient for what it claims. Thus, it is respectfully submitted that the disclosure is objectively sufficient in terms which correspond in scope to the claims. Furthermore, the specification describes the invention in such detail as to enable a person skilled in the most relevant art to make and use it.

Thus, the above noted enablement rejection is respectfully traversed for the reasons stated above, as well as those already made of record. Furthermore, the Examiner is respectfully requested to consider that he has not met the initial burden of establishing non-enablement, and that such a rejection is manifestly improper.

Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-22 under 35 U.S.C. § 112, First paragraph.

### **35 U.S.C. §112, 2<sup>nd</sup> Paragraph, Rejection**

Claims 1-23 were rejected under 35 U.S.C. §112, second paragraph, as indefinite. This rejection is respectfully traversed and/or rendered moot.

With regard to claim 9, the Examiner asserts that the use of the term "slip resistant" renders the claim indefinite because it is asserted to be a relative term. Applicants respectfully traverse this basis of rejection. Applicants submit that one having ordinary skill in the art having read the specification would have no difficulty understanding what is meant by this term. Indeed, the specification explains that such

a material "provides a significant resistance to slippage of a bowling ball entering the lift." (See page 10, lines 10-11). Moreover, the specification provides non-limiting examples of such materials, e.g., urethane materials and "[o]ther materials that provide similar material properties to urethane are acceptable and should be considered within the scope of this disclosure" (see page 10, lines 15-20).

With regard to claims 10-12, the Examiner asserts that these claims fail to further limit the structure of previously recited claims. Applicants respectfully traverse this basis of rejection as being contrary to current USPTO rules. There is no requirement in Section 112, second paragraph, requiring that the claims recite only structure. Current USPTO rules allow for claims which recite function and the Examiner has not demonstrated otherwise.

Applicants direct the Examiner's attention to MPEP 2173.05(g) which states:

A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does not, in and of itself, render a claim improper. In re Swinehart, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim - for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step. See, for example, In re Venezia, 530 F.2d 956, 189 USPQ 149 (CCPA 1976) wherein the Court held that in a claim directed to a kit of component parts capable of being assembled, limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly.

Thus, a rejection under Section 112, second paragraph based on the use of functional claim language is entirely improper.

With regard to claim 23, the Examiner asserts that the feature "the entire circumference" lacks proper antecedent basis. By this Amendment, Applicants have

amended claim 23 so as to render this basis of rejection moot.

Finally, Applicant would like to make general comments in response to the Examiner's grounds of rejection under 35 U.S.C. § 112, second paragraph. The breadth of a claim is not to be equated with indefiniteness. See MPEP 2173.04. As concerns the breadth of a claim, the primary concern is the scope of the claim relative to the scope of enablement provided to one skilled in the art by the disclosure. Claims should not be rejected as unduly broad under 35 U.S.C. §112, second paragraph, for non-inclusion of limitations dealing with factors which must be presumed within the level of one of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious. *In re Skrivan*, 427 F.2d 801, 166 USPQ 85 (C.C.P.A. 1970).

Moreover, Applicants submit that excessive 35 U.S.C. § 112, second paragraph rejections, should not be used as a substitute for prior art in an attempt to try to get Applicants to narrow the claims. Rather, 35 U.S.C. §112, second paragraph rejections, should pertain to definiteness and clarity of the claims.

Furthermore, definiteness of claim language is always analyzed in light of the teachings of the prior art, the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art, and the level of skill of the artisan in that art (*In re Moore*, 439 F.2d 1232, 169 USPQ 236 (C.C.P.A. 1971)). The essential question to be asked under 35 U.S.C. §112, second paragraph, is whether the scope of the invention sought to be patented can be determined from the language of the claims. If the answer is yes, then the claims should not be rejected as being indefinite based on the second paragraph of 35 U.S.C. §112. In particular, claims should be analyzed to determine whether they define the invention with a reasonable degree of particularity, clarity, and distinctness. See Patent and Trademark Office, Office of Policy and Dissemination Training Materials on Special Topics, 35 U.S.C. §112, Second Paragraph, provided by the U.S.P.T.O. Patent Academy to Examiners for training purposes (1998).

Thus, with respect to the above-noted formal rejections, Applicants traverse all

grounds of the Examiner's rejection based on the notion that the Examiner is only attacking the scope of Applicants claims, not definiteness. As mentioned above, the breadth of a claim is not to be equated with indefiniteness.

Needless to say, Applicants are of the opinion, that the Examiner has misapplied 35 U.S.C. § 112, second paragraph, to Applicants' claims.

Overall, the questions the Examiner presents are questions which can and should be easily answered by applying basic claim interpretation rules and also relying on the instant disclosure. Applicants respectfully refer the Examiner to review the specification so that the questions he presents can be answered.

Accordingly, Applicants assert that the above-noted Section 112, Second Paragraph rejection has been traversed and overcome and respectfully request withdrawal of the same.

### **35 U.S.C. §102 Rejection**

Claims 1, 2, 4-19 and 23-25 were rejected under 35 U.S.C. §102 over U.S. Patent No. 6,368,228 to Lanzetta ("LANZETTA"). This rejection is respectfully traversed.

The invention relates to a gripper kit for installation on a ball lift bowling ball return mechanism having opposed pulleys connected by an internal frame structure, and track rails opposing the opposed pulleys is provided. The gripper kit includes an endless belt positioned about the opposed pulleys and track rail covers covering the track rails. Additionally, tapered thimbles guide and facilitate delivery of a ball into a channel formed between the endless belt and at least a surface of a portion of the track rail covers.

Thus, independent claim 1 recites, for example:

tapered thimbles to guide and facilitate delivery of a ball into a channel formed between the endless belt and at least a surface of a portion of the track rail covers.

Moreover, independent claim 13 recites, for example:

a tension bracket attaching a mechanical linkage to the frame structure, the tension bracket having elongated slots for adjustment of position of a ball lift without removal of the tension bracket; and  
means for reducing a number of times a ratchet assembly actuates to lift a ball into a ball return entry area.

For the reasons already made of record as well as the following, Applicants submit that these features are clearly lacking in LANZETTA.

Applicants do not dispute that LANZETTA discloses a covered rail assembly for the bowling ball return of a bowling alley (Fig. 1-2 and Col. 2, lines 11-35). The disclosed ball return assembly 10 includes a ball elevating mechanism 11 having an endless belt 11A which engages a bowling ball 14 to roll up the latter via a rail assembly 12 (Fig. 1-2 and Col. 2, lines 11-16). The rail assembly 12 shown in Fig.3 uses a pair of laterally spaced rails 16, 16A. On each of the rails 16, 16A is a cover C having four sections, namely, the lower 17, an intermediate 18,19, and an upper section 20.

While LANZETTA shows that the lower section 17 is tapered, LANZETTA does not disclose, or even suggest, that the lower cover section 17 is anything resembling a thimble, much less, a tapered thimble, as recited in claims 1 and 13. As the Examiner will note, claim 1 clearly recites tapered thimbles to guide and facilitate delivery of a ball into a channel formed between the endless belt and at least a surface of a portion of the track rail covers. The sections 17, while shown as being tapered, are not tapered thimbles.

Applicants note that Webster's II *New College Dictionary* defines a thimble as "[a]ny of various tubular sockets or sleeves in machinery." As the Examiner has failed to identify any language in LANZETTA which discloses that the sections 17 are tapered tubular sockets or tapered tubular sleeves, the rejection of claim 1, and the claims which depend therefrom, are clearly improper. Nor do Applicants agree that the sections 17 can properly be characterizes as thimbles.

Furthermore, while Applicants acknowledge that LANZETTA describes sections such as section 17 as having "an open concave semi-cylindrical shape" so as to "closely" receive the rails 16 (see col. 2, lines 32-36), Figs. 3 and 7 clearly show that the sections do not completely surround the rails, are not round, and/or do not have a

cross-sectional shape comparable to the lower end of the rail covers. As a result, the sections 17 can at best be described as tapered partially sleeve shaped members, but not thimbles.

Furthermore, independent claim 13 recites the functional/structural equivalent of the thimbles in means-plus-function language using the language means for reducing a number of times a ratchet assembly actuates to lift a ball into a ball return entry area. As the Examiner will note, page 10, line 21 to page 11, line 4, defines the recited means as round members having a cross-sectional shape comparable to the lower end of the rail covers and which encloses the track rail so as to provide multiple wear surfaces. Thus, for reasons indicated above with regard to claim 1, the sections 17 can at best be described as tapered partially sleeve shaped members, but not thimbles.

Additionally, Applicants note that the Examiner completely neglected the feature in claim 13 reciting a tension bracket attaching a mechanical linkage to the frame structure, the tension bracket having elongated slots for adjustment of position of a ball lift without removal of the tension bracket. While it is apparent that Figs. 1 and 2 show a ball return mechanism with a bracket, the Examiner has failed to identify any language in LANZETTA which discloses, or even suggests, that the disclosed bracket is a tension bracket attaching a mechanical linkage to the frame structure, much less, one having elongated slots for adjustment of position of a ball lift without removal of the tension bracket. Nor has the Examiner set forth any explanation as to why he has chosen to completely disregard this claimed feature.

Finally, with regard to dependent claims 2, 4-12, 14-19 and 23-25, Applicants submit that these claims are allowable at least because they dependent from allowable claims 1 and 13. Moreover, with regard to the dependent claims which further define the thimbles and their position or mounting, Applicants submit that the Examiner is incorrect that LANZETTA discloses these features. As explained above, the lower sections 17 of the cover C cannot properly be characterized as thimbles, and do not, among other things, cover the end of the rail.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejection of the above-noted claims under § 35 U.S.C. § 102(b) and indicate that these claims are allowable.

**35 U.S.C. §103 Rejection**

Claims 3 and 20-22 are rejected under 35 U.S.C. §103(a) over LANZETTA in view of U.S. Patent No. 3,690,743 to Flototto ("FLOTOTTO"). This rejection is respectfully traversed.

As a preliminary matter, Applicants submit that this rejection is improper at least because the Examiner has identified only LANZETTA and FLOTOTTO as forming the basis of the rejection but discussed ERNST in the body of the rejection. While the Examiner has reference the corresponding rejection in the previous Office Action, that rejection was similarly improper for not specifically indicating that ERNST is being used to formally reject the claims. Thus, Applicants submits that this rejection is not understood, is contrary to current USPTO policy and practice, and should be reversed or at least clarified.

Moreover, it does not appear that the Examiner has properly set forth a rejection of claims 3 and 20-22. For example, the Examiner does not ever address many of the features of independent claim 20, i.e., the Examiner never addresses the use of thimbles, as recited in claim 20, which LANZETTA does not disclose, as discussed above. Also, the combination of references do not disclose or suggest this feature.

Furthermore, Applicants submit that the combination of references (even if proper which Applicants dispute) do not show the remaining features of the invention. For example, none of the references show a bracket with a series of elongated slots that provide the capability of adjustment. ERNST, for example, discloses a fixed bracket 80 fastened to the rod 54 in Figure 1. The bracket 20 has no apparent slots and there is no apparent adjustable mechanism, although ample opportunity was provided in the ERNST reference. In fact, it would appear to each away from an adjustable mechanism. As for FLOTOTTO, this document is non-analogous art since it is clearly directed to furniture, not a ball lift mechanism. There is no apparent basis or motivation to modify the ball lift of LANZETTA in view of the desk of FLOTOTTO. If anything, Applicants submit the Examiner is using inexpressible hindsight based on Applicants disclosure.

Applicants emphasize that FLOTOTTO has absolutely nothing to do with a ball lift mechanism, and one skilled in the art would not look to furniture or desks when

addressing ball lift mechanism issues. Certainly, the Examiner's assertion is incorrect in finding a suggested teaching, or support, or motivation in applying the FLOTOTTO reference. Thus, Applicants submit that this rejection is entirely improper.

Accordingly, Applicants request that the Examiner reconsider and withdraw the rejections of claims 3 and 20-22 under § 35 U.S.C. 103(a) and indicate that these claims are allowable.

### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue. The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicants hereby make a written conditional petition for extension of time, if required. Please charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 19-0089.

Respectfully submitted,  
LeRoy Thomas WARREN, Jr., et al.

A handwritten signature in black ink, appearing to read 'Andrew M. Calderon', with a large, stylized flourish at the end.

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